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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/983,605 05/01/98 RODER

M 2936.104/00

EXAMINER

HM12/0225

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BUI, P	
ART UNIT	PAPER NUMBER

1645

12

DATE MAILED:

02/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/983,605

Applicant(s)
Roder et al.

Examiner
Phuong Bui

Group Art Unit
1645



☒ Responsive to communication(s) filed on Dec 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4, 6-8, and 11 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6-8, and 11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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DETAILED ACTION

1. The Office acknowledges the receipt of Applicant's preliminary Amendment D, Paper No. 11, filed December 13, 1999. Claims 1-4, 6-8 and 11 are pending and are examined in the instant application.

Specification

2. The abstract has been received and entered. For future reference, the abstract should be on a separate sheet of paper.

35 U.S.C. 112, second paragraph

3. Claims 1-4, 6-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear how many microsatellite markers are in a set. The claims are drawn to "A set of microsatellite markers", and each of the markers is defined by a pair of primers. If a set is minimally two, then would a minimum of two pairs of primers be required to meet the claim limitations?

Also in claims 1 and 6, is a microsatellite marker the same as a microsatellite sequence?

In claim 3, it is unclear how a "composite microsatellite sequence" is defined. What are the metes and bounds of "composite"?

In claim 4, it is unclear how an "imperfect sequence" is defined. Also, which bases are being mutated: the primer sequences or the microsatellite markers? If all the primer bases are

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mutated, wouldn't these primers anneal to sequences which are not microsatellite sequences?

Applicant's statement on page 8 in regard to claim 4 does not further clarify the above issues, since it is unclear what sequences may mutate in random fashion, what "individual sequences" are being referred to, what is being identified as mutations, and what pattern does not need to be established.

In claim 6, it is unclear how a "polymorphic fragment" is defined. Are all separated microsatellite sequences polymorphic fragments?

In claim 7, "highly resolving" is a relative term lacking a comparative basis.

In claim 11, "the 233 primer pairs" lack antecedence. Also, by "all of the 233 primer pairs", does Applicant mean that the claimed set of microsatellite markers would consist of all markers identified by all 233 primer pairs?

Clarification and/or correction are required.

Conclusion

4. No claims are allowed.

5. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1645, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui
Patent Examiner
Group Art Unit 1645
February 23, 2000


PHUONG T. BUI
PATENT EXAMINER